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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,607	05/31/2001	Masashi Inoue	0879-0315P	7047

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EXAMINER

VILLECCO, JOHN M

ART UNIT	PAPER NUMBER
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2622

NOTIFICATION DATE	DELIVERY MODE
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12/19/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

09/867,607

Applicant(s)

INOUE ET AL.

Examiner

John M. Villecco

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 7, 11, 14 and 18-20 is/are rejected.
- 7) ☒ Claim(s) 4, 5, 7-10, 12, 13, 15-17 and 21-26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/20/07</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The prosecution of this application has been transferred to Examiner John M. Villecco from the docket of Examiner Lin Ye. Any inquiry concerning this Office Action or earlier communications should be directed to the current Examiner of record. Current contact information is provided in the last section of this communication.

Response to Pre-Appeal Brief Request for Review

2. In the paper received August 10, 2007, applicant request a Pre-Appeal Brief Conference Review of the Final Rejection mailed out on May 10, 2007. As a result of the Pre-Appeal Brief Conference Review, the panel elected to re-open prosecution of the application. Applicant's arguments with respect to claims 1-26 have been fully considered and are persuasive. The 35 U.S.C. rejections of claims 1-26 have been withdrawn. However, after further consideration and search, additional art has been found that is readable upon the claims. In addition, some additional informalities have been noted in the claims.

3. Accordingly, **this action is non-final** due to the new grounds of rejection, which was not necessitated by amendment. Please see the new grounds of rejection presented on the following pages. The Examiner apologizes for the delay in prosecution.

Claim Objections

4. Claim 7 is objected to because of the following informalities:

- In line 2 of claim 7, applicant recites the phrase "that calculating". This appears to be a typographical error and that the applicant meant to use the phrase – that calculates –.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 18-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 18-20 recite the limitation "the table" in lines 2 and 3. There is insufficient antecedent basis for this limitation in the claim. It appears that applicant has inadvertently made claims 18-20 depend from claim 12. For examination purposes, it will be assumed that applicant meant to depend claims 18-20 from claim 17.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 1, 6, 11, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski et al. (U.S. Patent No. 5,402,170).**

10. Regarding *claim 1*, Parulski discloses a camera connected to a computer in which the computer is capable of setting capture parameters. More specifically, Parulski discloses a camera (40) connected to a computer (12). Parulski discloses that the number of imaging pixels and image compression rate are displayed and capable of being selected by the user. Furthermore, the image compression rate and number of imaging pixels are displayed in a two-dimensional arrangement. See Figure 4 and column 5, lines 45-68. The process of selectably displaying the image compression rate and the number of imaging pixels is interpreted by the examiner to be "presenting to a user combinations of selectable number of imaging pixels and the image compression rates"... "wherein the number of imaging pixels and the image compression rates are each directly selectable". The number of imaging pixels and the image compression rate are changed in response to the selected quantities. "Compression off" in Figure 4 and the specification is interpreted to be a compression rate of zero. Additionally, Parulski discloses the use of a keyboard (18) for selecting the desired number of pixels and compression rate. Although it appears that a mouse or other like input device is used for selecting the parameters in Figure 4, Parulski only discloses a keyboard (18).

Thus, Parulski fails to explicitly disclose receiving an instruction for moving a cursor on the setting screen or changing the settings of the parameters by pointing the cursor at the parameters to designate a selection. However, Official Notice is taken as to the fact that it was well known in the art at the time the invention was made to use a mouse as an input device for a computer to enter or selected desired data on a computer screen. The use of a mouse and the

associated mouse cursor allow for quick and easy selection of data on a computer screen.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a mouse to select the number of imaging pixels and the compression rate in the computer of Parulski so that quick and easy selection of the camera parameters can be facilitated.

11. As for *claim 11*, Parulski discloses that the number of imaging pixels and the image compression rate are changed independently.

12. Regarding *claim 6*, Parulski discloses a camera connected to a computer in which the computer is capable of setting capture parameters. More specifically, Parulski discloses a taking lens (22), an imaging device (sensor, 24), a signal processing part (signal processor/controller, 32), a recording instruction input operation part (shutter release, 36), and a recording device (personal computer, 12) that records an image in a storage medium (disk drive, 20).

Additionally, although not specifically disclosed, Parulski inherently discloses a display device within the personal computer (12) that displays a setting screen for setting an image quality. See Figure 4 and column 5, lines 53-65. Parulski discloses that the number of imaging pixels and image compression rate are displayed and capable of being selected by the user. Furthermore, the image compression rate and number of imaging pixels are displayed in a two-dimensional arrangement. See Figure 4 and column 5, lines 45-68. Thus, a display control device would also be inherent within the personal computer (12) of Parulski. The number of imaging pixels and the image compression rate are changed in response to the selected quantities.

“Compression off” in Figure 4 and the specification is interpreted to be a compression rate of zero. Additionally, Parulski discloses the use of a keyboard (18) for selecting the desired

number of pixels and compression rate. Although it appears that a mouse or other like input device is used for selecting the parameters in Figure 4, Parulski only discloses a keyboard (18).

Thus, Parulski fails to explicitly disclose a cursor operating device that inputs an instruction for moving a cursor on the setting screen or a designation instruction device that instructs a designation indicated by the cursor. However, Official Notice is taken as to the fact that it was well known in the art at the time the invention was made to use a mouse as an input device for a computer to enter or selected desired data on a computer screen. The use of a mouse and the associated mouse cursor allow for quick and easy selection of data on a computer screen. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a mouse to select the number of imaging pixels and the compression rate in the computer of Parulski so that quick and easy selection of the camera parameters can be facilitated.

13. With regard to *claim 14*, Parulski discloses a camera connected to a computer in which the computer is capable of setting capture parameters. More specifically, Parulski discloses memory (disk drive, 20) for storing an image, a processor (signal processor/controller, 32) coupled to the memory (disk drive, 20) for displaying the number of imaging pixels and image compression rate. Furthermore, the image compression rate and number of imaging pixels are displayed in a two-dimensional arrangement according to predetermined combinations. See Figure 4 and column 5, lines 45-68. The predetermined combinations are all of the predetermined compression rates and image pixel quantities. The number of imaging pixels and the image compression rate are selected in response to a user selection. "Compression off" in Figure 4 and the specification is interpreted to be a compression rate of zero. Additionally, Parulski discloses the use of a keyboard (18) for selecting the desired number of pixels and

compression rate. Although it appears that a mouse or other like input device is used for selecting the parameters in Figure 4, Parulski only discloses a keyboard (18).

Thus, Parulski fails to explicitly disclose receiving an instruction for moving a cursor on the setting screen or changing the settings of the parameters by pointing the cursor at the parameters to designate a selection. However, Official Notice is taken as to the fact that it was well known in the art at the time the invention was made to use a mouse as an input device for a computer to enter or selected desired data on a computer screen. The use of a mouse and the associated mouse cursor allow for quick and easy selection of data on a computer screen. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a mouse to select the number of imaging pixels and the compression rate in the computer of Parulski so that quick and easy selection of the camera parameters can be facilitated.

14. **Claims 2 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski et al. (U.S. Patent No. 5,402,170) in view of Akazuka (Japanese Publ. No. 62-252583).**

15. Regarding *claim 2*, as mentioned above in the discussion of claim 1, Parulski discloses most of the limitations of the parent claim. Additionally, Parulski discloses that the user specifies the number of images to be taken and then determining whether the required amount of disk space is sufficient for the specified number of images. In Figure 4, the memory required for the settings and the memory available are displayed to the user. However, the 35 U.S.C. rejection of claim 1 does not disclose displaying the number of photographable images in accordance with the number of imaging pixels and the image compression rate which are

selected. Akazuka, on the other hand, discloses that it is well known in the art to display the number of recordable images remaining based on the compression and number of image pixels in the captured image. More specifically, Akazuka discloses that based on a compression and number of image pixels (lines 1-3 of page 4) the remaining recordable image number is displayed by the display means (23). This feature allows to inform the user of the number of images capable of being captured based on the capture settings and the remaining available memory. See the "Problems to be solved by the invention" section. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to display the number of photographable images remaining in the camera of Parulski so that the user is apprised of the number of remaining images capable of being recorded.

16. **Claim 7** is rejected as being substantively equivalent to claim 2. Please see the discussion of claim 2 above. Since the claim language recites that the calculation device calculates "at least one of" the number of photographable images and the remaining time for recording a moving image, the examiner is using the Akazuka reference to teach the limitation of calculating the number of photographable images. In other words, only one of the two choices in the claim language has to be met and Akazuka discloses the limitation of calculating the number of photographable images.

17. **Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski et al. (U.S. Patent No. 5,402,170) in view of Mizoguchi (U.S. Patent No. 6,407,772).**

18. Regarding **claim 3**, as mentioned above in the discussion of claim 1, Parulski discloses most of the limitations of the parent claim. Additionally, Parulski discloses that the amount of

recording space needed to record a number of still image frames directly depends upon the number of imaging pixels and the compression rate. See column 5, line 45 to column 6, line 40. Parulski, however, fails to specifically disclose that a remaining time for recording a moving image is displayed on the setting screen in accordance with the number of imaging pixels and the image compression rate. Mizoguchi, on the other hand, discloses that it is well known in the art to display the amount of time left for recording a moving image and that the amount of time left depends on the compression rate. More specifically, Mizoguchi discloses a camera (Figure 1) for recording still images or continuous (moving) images. When in the continuous recording mode, the camera displays on the display (7) the amount of time left for recording on the memory card. Furthermore, the amount of recording time left depends upon the compression rate (column 5, lines 42-49).

19. The ability to allow a user to capture both still and motion images has become very desirable to electronic camera users. This feature allows different options for the user of the camera by allowing the user to collect images other than still images. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the camera of Parulski to also capture moving images, thereby giving the user more options when capturing images.

20. Additionally, the ability to display the amount of recording time left on a memory device when capturing moving images provides the user with the knowledge of the remaining memory so that exhaustion of the capacity can be prevented in advance. See column 5, lines 45-49 of the Mizoguchi reference. Therefore it would have been obvious to one of ordinary skill in the art to

display the amount of remaining recording time on the display of Parulski when capturing a moving image so that the exhaustion of the memory capacity can be prevented in advance.

Allowable Subject Matter

21. Claims 4, 5, 8-10, 12, 13, 15-17, and 21-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claims 4 and 9, the primary reason for indication of allowable subject matter is that the prior art fails to teach or reasonably suggest that information on a combination of the number of imaging pixels and the image compression rate which have been set in a previous setting are stored and when one of the number of imaging pixels and the image compression rate is changed by an operation of the user, the cursor automatically moves to a position of the other of the number of imaging pixels and the image compression rate in the previous setting according to the stored information.

As for claims 5 and 10, the primary reason for indication of allowable subject matter is that the prior art fails to teach or reasonably suggest that when one of the number of imaging pixels and the image compression rate is changed by an operation of the user, the cursor automatically moves to a position of the other of the number of imaging pixels and the image compression rate in a predetermined default.

Regarding claim 8, the primary reason for indication of allowable subject matter is that the prior art fails to teach or reasonably suggest that a table is prepared in which one of the selectable candidates for the number of imaging pixels and the image compression rate is

horizontally lined up as a row, and the other is vertically lined up as a column on the setting screen and at least one of the number of photographable images and the remaining time for recording a moving image for the combination is displayed in each cell of the table.

With regard to claims 12 and 15, the primary reason for indication of allowable subject matter is that the prior art fails to teach or reasonably suggest that the number of candidates for the number of imaging pixels will depend upon the image compression rate selected.

Regarding claim 13 and 16, the primary reason for indication of allowable subject matter is that the prior art fails to teach or reasonably suggest that the number of candidates for the image compression rates will depend upon the number of imaging pixels selected.

As for claim 17, the primary reason for indication of allowable subject matter is that the prior art fails to teach or reasonably suggest that the two-dimensional format further comprises a table having the selectable options arranged as table headings.

With regard to claims 21, 22, and 23, the primary reason for indication of allowable subject matter is that the prior art fails to teach or reasonably suggest that the two-dimensional arrangement comprises a two-dimensional matrix having a plurality of selectable cells, each selectable cell corresponds to a combination of number of pixels and image compression rate, and is designated by a user to set the number of pixels and image compression rate.

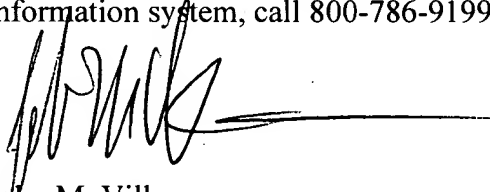
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Villecco whose telephone number is (571) 272-7319. The examiner can normally be reached on Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Ometz can be reached on (571) 272-7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



John M. Villecco
Primary Examiner, Art Unit 2622
December 11, 2007